



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/683,944

03/05/2002

Christopher L. Parmelee

D-1154R3

5491

28995

7590

02/13/2006

RALPH E. JOCKE

walker & jocke LPA

231 SOUTH BROADWAY

MEDINA, OH 44256

EXAMINER

ABDI, KAMBIZ

ART UNIT

PAPER NUMBER

3621

DATE MAILED: 02/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/683,944

Applicant(s)

PARMELEE ET AL.

Examiner

Kambiz Abdi

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 November 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 3621

DETAILED ACTION

1. The prior office actions are incorporated herein by reference. In particular, the observations with respect to claim language, and response to previously presented arguments.
 - Claims 1-10 are amended.
 - Claims 12-20 are added.
 - Claims 1-20 have been considered.
2. Examiner withdraws prior rejections of claims 1-11 under 35 U.S.C. 112-second paragraphs due to amendments by the applicant. However, new grounds of rejection under 35 U.S.C. 112-second paragraphs have been presented, which are presented below.
3. Examiner withdraws rejection of claims 1-11 under 35 U.S.C. 101 due to amendments and arguments by the applicant.

Response to Arguments

4. Applicant's arguments filed 2 November 2005 have been fully considered but they are not persuasive as well as they are moot in view of the new ground(s) of rejection necessitated by applicants' amendments as well as new added claims. It should be noted that the arguments the applicants have made have been addressed by providing references to further provide evidence and additional clarification of the office's position as they have been stated below in the new rejection.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.
6. Claims 12-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 3621

7. For example in claims 1, 12, 14, 15, and 17 the phrase "adapted for ..." makes the claims indefinite and unclear in that neither means nor interrelationship of means are set forth in the claims in order to achieve the desired results expressed in the phrase "adapted for..."

8. It should be emphasized that the phrase "adapted for..." is vague in its nature due to that it does not positively recite the action and the steps that need to be performed by the method and steps, it only implies that such steps could be taken and it does not necessary makes it so. Therefore, the claims are rendered to be indefinite and failing to particularly point out what are the steps that must be performed.

9. Additionally in claims 12, 14, 15, and 17, the phrase "to be..." makes the claims indefinite and unclear in that neither means nor interrelationship of means are set forth in the claim in order to achieve the desired results expressed in the phrase "to be..."

10. Dependent claims 2-11, 13-16 and 18-20 are unclear in that they depend from unclear independent claims.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,943,423 to Sead Muftic in view of U.S Patent No. 6,895,386 to Richard Bachman et al.

13. As per claims 1-3, Muftic clearly teaches a method comprising:

Art Unit: 3621

a) producing a plurality of digital certificates for a plurality of individual customers, wherein each individual customer is associated with an account (See Muftic figure 3-4 and associated text and column 9, line 45- column 10, line 62, column 12, line 65-column 14, line 36);

b) associating through operation of at least one computer the accounts of the individual customers with the corresponding digital certificates of the individual customers (See Muftic figure 3-4 and associated text and column 3, line 45- column 4, line 17, column 9, line 45- column 10, line 62, column 12, line 65-column 14, line 36);

c) producing at least one card for each of the individual customers, wherein each card includes first visible digital signature service source indicator marking indicia thereon corresponding to a digital signature service, wherein each card includes machine readable data corresponding to an account number associated with the account of the individual customer (See Muftic figure 3-4, 20 and associated text and column 3, line 45- column 4, line 17, column 9, line 45- column 10, line 62, column 12, line 65- column 14, line 36);

d) sending the cards to the individual customers (See Muftic column 9, line 45- column 10, line 62); and

e) digitally signing an electronic document through operation of one of a plurality of automated transaction machines, wherein each automated transaction machine is adapted to display a visual representation of the electronic document through a display device of the automated transaction machine, wherein each automated transaction machine is adapted to cause the electronic document to be digitally signed responsive to communication with the digital signature service, wherein in signing the electronic document at the one machine the communication includes the account number on a card read by the one automated transaction machine (See Muftic figure 3-4, 20, 25, 28 and associated text and column 3, line 45- column 4, line 17, column 9, line 45- column 10, line 62, column 12, line 65-column 14, line 36).

the second visible digital signature service source indicator mark indicia is labeled at least one of on and adjacent a fascia of each of the automated transaction machines, wherein in step (e) the first

Art Unit: 3621

visible digital signature service source indicator mark indicia on the card and the second visible digital signature service source indicator mark indicia on the one machine are visually similar.

However it is not clear in Muftic if there are any marking visible to the user at the terminal performing the transaction. However, Bachman clearly teaches that for a verity of purposes and specifically for the purpose of identifying the ATM/CAT systems that would work with card to have similar visible markings such as logos or Trademarks that are placed on the card as well as the ATM/CAT (See Bachman figures 1-3 and column 5, lines 41-49).

Additionally, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to place indicia indicating markings of the entity, providing service to the user to make sure that the user is communicating with the appropriate certifying authority providing the services. For example, ATM's bearing multiple markings for Visa, Master Card, Amex, or other intercommunity service providers in the financial area such as Plus or Cirrus (For further information on the well established practice of logo display on ATMs as well as cards display of corresponding logo, refer to U.S. Patent No. 6,336,590 to Kubitz column 1, lines 38-42) use and display the appropriate logo or marking, both on the ATM and the card, also most ATM machine bear their marking to advise the user that their financial card such as credit cards or bank transaction cards are serviceable at that ATM point of transaction based on their affiliation with multiple service providers. Furthermore, when a user visits a web site (Such as Amazon.com or Dell.com or any online merchants or service providers) and wants to conduct a purchase or any other transactions online, such markings are provided to inform the user that they may use their credit cards such as MasterCard or Visa, charge cards such as American Express or Dinnars Club, or just their Bank cards (transaction token). It is customary in the art to advise the users of what type of credit card or charge cards are acceptable by the system such as an ATM or online purchase, to provide the user with more flexibility and choice as well as well as compatibility.

Art Unit: 3621

14. As per claims 4 and 15, Muftic clearly teaches the method according to claims 1 and 12, further Muftic teaches in step (a) each digital certificate includes a public key that corresponds to a private key, wherein in step (e) communication with the digital signature service causes the electronic document to be digitally signed responsive to a private key that corresponds to a public key of a digital certificate associated with the account corresponding to the account number read from the card by the one machine (See Muftic column 3, line 62-column 4, line 51, and column 5, lines 23-47, column 12, line 65-column 13, line 26).

15. As per claims 5 and 14, Muftic clearly teaches the method according to claims 1 and 12, further Muftic teaches in step (e) the digital signature service is operative to access a private key associated with the account number read from the card, wherein the digital signature service is operative cause the electronic document to be digitally signed responsive to the private key (See Muftic figure 4 and column 9, line 45-column 10, line 23).

16. As per claims 6, 10, 13, and 20, Muftic clearly teaches the method according to claims 1 and 12, further Muftic teaches in step (c) each of the cards produced correspond to financial account cards, and wherein the accounts correspond to financial accounts (See Muftic column 20, line 57- column 21, line 7). In addition, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to interconnect the financial account information of a user to associate with certification authority of the public/private key management system, they might even be the same for the reason that makes a single token more controllable and in addition it would be beneficial to only use one card or smart token to conduct multiple transaction rather than having multiple cards associated with multiple entities for conducting secure transaction. For example as it is thought by U.S. Application Publication No. 2002/0004783 to Cris T. Paltence et al. priority date of 14 April 1998.

Art Unit: 3621

17. As per claim 7, Muftic clearly teaches the method according to claim 6, further Muftic teaches operating the one automated transaction machine to cause a processing fees to be assessed to a customer associated with the card read by the one automated transaction machine for the digital signing of the electronic documents, and further comprising:

f) providing through operation of at least one computer to an entity that manages a financial accounts for the customers, at least a portion of the processing fees. (See Muftic column 14, lines 7-22). However, it is also an essential part of financial transactions to charge fees for conduction such transaction. For example it is well known in the art that if one is using an ATM that does not belong to their own network such as a bank ATM network the out side network let say the card was issued by SunTrust bank and the user uses the Bank of America ATM, there is a fee that is charged by the user's bank SunTrust and another fee by the Bank of America which is paid by the SunTrust bank to Bank of America on behalf of the user for using the Bank of America network. Therefore, it is an obvious to have added such fee structure to the current Muftic's system and method. Further evidence of the well-known practice can be seen in the U.S. Patent Application Publication No. 2002/0032656 to Christopher Chen for example refer to figures 1a-8 and paragraphs [0010] and [0039] in Chen supporting document.

18. As per claims 8 and 16, Muftic clearly teaches the method according to claims 1 and 12, further Muftic is not explicit on the one automated transaction machines includes a digitizing signature pad and further comprising operating the one automated transaction machine to include handwritten signature data captured with the digitizing signature pads in association with the electronic documents. However, it is well known in the art of utilizing such devices for capturing actual hand written signatures as well as other digitized information at the point of sale or transaction for further assurance of evidentiary of the users identification. Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to combine the two concepts to enhance the identification of the user at the point of sale or transaction as well as keeping records of actual human entered evidence of presence for archiving and identification. Further evidence of such common knowledge of using digital

Art Unit: 3621

signature pads as well as cash dispensers and cash receiving systems and methods for an ATM system can be found in the following U.S Patent No. 5,992,570 to Joanne S. Walter et al. for example in column 3, line 64-column 4, line 5 and U.S. Patent No. 6,308,887 to Bruce R. Korman et al. for example in figures 2-3 and column 5, lines 39-68.

19. As per claims 9 and 19, Muftic clearly teaches the method according to claims 1 and 17, further Muftic teaches at least some of the automated transaction machines include cash dispensers, wherein the automated transaction machines that include cash dispensers are further operative to dispense cash (See Muftic column 1, lines 34-40). For further evidence of such common knowledge of using cash dispensers and cash receiving systems and methods for an ATM system can be found in the following U.S Patent No. 5,992,570 to Joanne S. Walter et al. for example in column 3, line 64-column 4, line 5 and U.S. Patent No. 6,308,887 to Bruce R. Korman et al. for example in figures 2-3 and column 5, lines 39-68.

20. As per claim 11, Muftic clearly teaches the method according to claim 1, further Muftic teaches in step (a) the accounts correspond to digital secure repository accounts, wherein in step (c) the cards correspond to digital secure repository account cards (See Muftic figures 14, 15, and 25-26 and column 2, lines 53-59, column 4, lines 39-51, column 11, lines 37-38). It would be also obvious to one skill in the art that secure repositories at a remote server as it is known in the art as secure server repositories can be used for storing information or documents such as in secure vaults. Therefore, it would have beneficial to have added to the system of Muftic as an additional convenience to users to have all their important documents in a single secure repository online such as services provided by online service like Yahoo, Hotmail, or ISPs. Also, further evidence of such secure repositories can be found in U.S. Patent Application Publication. 2005/0246292 with the priority date of 14 April 2000 to Branko Sarcenin for example in paragraphs [0139]-[0141], which clearly teaches the objectives of such virtual deposit safe box.

Art Unit: 3621

21. As for claims 12 and 17, they being substantially the same as above claims the rejections provided above are applicable to the same.

22. Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

Conclusion

23. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

24. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

25. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the examiner should be directed to **Kambiz Abdi** whose telephone number is **(571) 272-6702**. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **James Trammell** can be reached at **(571) 272-6712**.

Art Unit: 3621

26. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair>.

Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks
Washington, D.C. 20231**

or faxed to:

(571) 273-8300 [Official communications; including After Final communications labeled "Box AF"]

(571) 273-6702 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to the Examiner in the

Knox Building, 50 Dulany St. Alexandria, VA.

Kambiz Abdi
Primary Examiner

February 6, 2006

Ar 3621